

Office Action Summary

Application No.

10/620,154

Applicant(s)

TALABER ET AL.

Examiner

Anu Ramana

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 52, 53, 63-69, 73, 115-119, 122-124 and 126 is/are rejected.
- 7) ☒ Claim(s) 31, 33-35, 42, 47 and 106 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-646)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 2/11/2010
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-28, 30-31, 33-35, 37-40, 42-60, 63-79, 84-86, 88, 90-91, 93, 95, 98, 102, 105-106, 108, and 111-126.

Continuation of Disposition of Claims: Claims allowed are 1-28, 30, 37-40, 43-46, 48-51, 54-60, 74-79, 84-86, 88, 90, 91, 95, 98-102, 105, 108, 111-114, 120, 121 and 125.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 24, 2010 has been entered.

Claim Objections

Claims 31, 122 and 126 are objected to because of the following informalities.

The clean copy of the claims submitted on March 19, 2010 does not have the correct claim dependency. It appears that claim 31 should depend on claim 120 instead of claim 29 which has been canceled. It is noted that all references to line numbers are with respect to the clean copy of claims filed on February 24, 2010.

In claim 31, it appears that "securing member" should be - - securing element - - to correct a minor typographical error.

In claim 122, line 4, "an attachment" should be "attachment member" to correct a minor typographical error.

It is also not clear whether claim 126 depends on claim 120 or claim 125.

Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 115-119 and 126 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 115, the recitation "c. the stopping member defines at least in part a length of the posterior bore portion.....within the posterior bore portion." seeks to introduce new matter. Applicant's disclosure, as originally filed, recites "the posterior section 25 of the transverse passageway is sufficiently longer than the head 24 of the securing element so that the head can be displaced anteriorly and posteriorly, and is thus longitudinally displaceable within the posterior section of the transverse passageway (col. 5, lines 46-51 of US 6,261,291)."

In claim 126, the recitation "at least one of the anterior surface of the head" seeks to introduce new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52-53, 115-119 and 122-124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is noted that all references to line numbers are with respect to the clean copy of claims filed on February 24, 2010.

In claim 52, line 11, the recitation "smaller than transverse dimensions of the anterior bore portion" renders the claim vague and indefinite since it is unclear which transverse dimension is being referred to. It is suggested that Applicant recite "smaller than a transverse dimension of the anterior bore portion" for clarity.

In claim 115, lines 15-19, the recitation "c. the stopping member defines in part a length of the posterior bore portion.....the enlarged integral portion of the securing member within the posterior bore portion." renders the claim vague and indefinite

because the structure being recited is unclear. The stopping member does not define the length of the posterior bore portion.

In claim 122, lines 11-13, the structure being recited is unclear due to runon recitation of structural features. It is suggested that language similar to "each of said stopping members having a posterior stopping surface, a first configuration wherein the stopping members extend within the bore and wherein the stopping members are elastically deformed" for clarity.

In claim 123, the recitation "stopping element comprises one or more contractible fingers" renders the claim vague and indefinite since it isn't clear whether the biased stopping members are contractible fingers or whether the contractible fingers are additional structural elements.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 52-53, 63-69 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Errico et al. (US 5,876,402).

Errico et al. disclose an orthopedic implant assembly including: a stabilizing element 100; a bore 111 having an anterior bore portion and a posterior bore portion, the posterior bore portion having a transverse dimension smaller than a transverse dimension of the anterior bore portion; a securing member 120 having an enlarged integral portion or head 122; a stopping element or snap-ring or collar 180 disposed within the bore, the snap ring having a first configuration or deflected state allowing

passage of the securing member into the posterior bore portion and a second or undeflected state that facilitates retention of the enlarged integral portion of the securing member within the posterior bore portion (Figs. 3b and 6, col. 5, lines 41-67 and col. 6, lines 1-55).

The method steps of claims 52 and 53 are inherently performed when the Errico et al. implant is attached to bone.

Response to Arguments

Applicant's arguments and claim amendments filed on February 24, 2010 have been carefully considered by the examiner. It is noted that the Examiner had a telephone interview with the Attorney of Record, Mr. Edward J. Lynch on Thursday, August 5, 2010. However, due to new rejections made in this office action, the Examiner is unable to allow the instant application with an Examiner's Amendment. The Examiner sincerely apologizes for any inconvenience caused to the Applicant by this action.

Applicant's arguments with respect to the rejections under 35 USC 112 first paragraph made in the previous office action are found to be persuasive. Support for the limitation of claim 120 "the posterior stopping surface of the biased stopping member configured to engage with the anterior surface of the enlarged integral portion of the securing member facilitating retention of the enlarged portion of the securing member within the posterior bore portion of the attachment member" and variations thereof in claims 121, 122 and 125, is found at col. 5, lines 25-30 of US 6,261,291. Accordingly, the examiner is withdrawing the rejection under 35 USC 112 first paragraph made in the previous office action.

Allowable Subject Matter

Claims 1-28, 30, 37-40, 43-46, 48-60, 74-79, 84-86, 88, 90, 91, 93, 95, 98-102, 105, 108, 111-114, 120-121 and 125 are allowed.

Claims 31, 33-35, 42, 47 and 106 would be allowable if the minor objection made in this office action is addressed.

Claims 70-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 122-124 would be allowable if the rejection under 35 U.S.C. 112 second paragraph made in this action is overcome.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
August 8, 2010

/Anu Ramana/
Primary Examiner, Art Unit 3775